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Paper No. 5

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JUN 20 2002

OFFICE OF PETITIONS

In re Application of :
Matti Hiltunen, Jukka Liukkonen and :
Harri Vatanen :
Application No. 09/931,338 :
Filed: August 16, 2001 :
Title: METHOD FOR TRANSMISSION OF :
SECURE MESSAGES IN A :
TELECOMMUNICATIONS NETWORK :

DECISION REFUSING STATUS
UNDER 37 C.F.R. §1.47(a)

This is in response to the "Petition under 35 U.S.C. §116 and 37 C.F.R. §1.47(a)," filed Monday, April 22, 2002.

The petition is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. §1.136(a).

The above-identified application was filed on August 16, 2001, with an unexecuted declaration. Matti Hiltunen, Jukka Liukkonen and Harri Vatanen were named as joint inventors. Accordingly, on September 21, 2001, applicants were mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted (Notice)," requiring an executed oath or declaration and a surcharge for its late filing. This Notice set a two-month period for reply with extensions of time obtainable under §1.136(a).

In response, applicants filed a declaration executed by joint inventors Hiltunen and Liukkonen on behalf of themselves and on behalf of joint inventor Vatanen; the surcharge under §1.16(e); and the instant petition under §1.47(a). This response was made timely by an accompanying petition for extension of time within the fifth month. Applicants assert that status under §1.47(a) is proper because inventor Vatanen has refused to execute the subject U.S. Patent Application despite diligent efforts to have him sign a declaration in support the application.

A grantable petition under 37 C.F.R. §1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or found, after diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification,

claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. The instant petition does not satisfy requirement (1).

Rule 47 applicants have not submitted adequate proof of refusal. Petitioner has not shown that inventor Vatanen by his conduct refuses to join in the application. Before a refusal can be alleged, applicants must demonstrate that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor. See MPEP 409.03(d). The evidence only supports a conclusion that the combined declaration and power of attorney were sent to inventor Vatanen. The evidence indicates that Sonera was forwarded a copy of the application as filed, but Sonera forwarded only a declaration and assignment to inventor Vatanen for signature. A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Thus, on renewed petition, applicants must establish that the entire application package, including specification, claims and drawings, was presented to the non-signing inventor and he refused to sign. A copy of the application papers should be sent to the last known address of the non-signing inventor, or, if the inventor is represented by counsel, to the address of the non-signing inventor's attorney. Documentary evidence, including copies of the transmittal cover letters and return mail receipts, should be made part of the record.

Furthermore, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. Thus, on renewed petition, a new declaration of facts from European Patent Attorney Markku Simmelvuo or other proper party, such as the employee of Sonera who presents the papers, is required.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
 Box DAC
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Telephone inquiries related to this decision may be directed to the undersigned at (703) 305-0309.

A handwritten signature in black ink, appearing to read "Nancy Johnson". The signature is fluid and cursive, with a large initial "N" and a long, sweeping underline.

Nancy Johnson
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy